

REMARKS

Claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 are pending. By this Amendment, claims 18-20, 50, 53, 55, and 57 are canceled, claims 16-17, 21-26, 33, 49, 51, 56, and 58-60 are amended. Claims 35-48 were withdrawn from consideration in a previous Office Action and claims 61-70 are withdrawn from consideration in the 14 July 2003 Office Action.

Claim 16 is amended to recite "at least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel," "each said at least one ventilator section ~~configured for~~ in parallel abutting contact with the top panel," and "the top panel and each said ventilator first and second panel comprising first and second planar plies and an intermediate ply disposed between the first and second plies such that the first and second planar plies and the intermediate ply define a multiplicity of air passages (added portions underlined, deleted portions in strikethrough).

Claim 17 is amended to depend from claim 16.

Claim 21 is amended to delete redundant recitations to "second panel" ("further comprising ~~a second panel and a third panel~~" and "each said ~~second and~~ third panel") and to recite a more positive relation between the top, first, second, and third panels ("the top panel and each said first panel, second panel, and third panel ~~configured for~~ in parallel abutting contact") (added portions underlined, deleted portions in strikethrough).

Claim 22 is amended to delete redundant recitations to "second panel" ("further comprising ~~a second panel and a third panel, the second panel and~~ third panel including first and second planar plies and an intermediate ply") and to replace "section" with "panel" ("the top panel and each said first, second, and third ventilator ~~section~~ panel being defined by a generally linear series of perforations") (added portions underlined, deleted portions in strikethrough).

Claim 23 is amended to delete redundant recitations to "second panel" ("further comprising ~~a second panel and a third panel, the second panel and~~ third panel including first and second planar plies") and to recite "each of said ~~slit~~ slits formed by severing one of the first and second planar plies and the intermediate ply" (added portions underlined, deleted portions in strikethrough).

Claim 24 is amended to delete a redundant recitation to "second panel" ("further comprising ~~a second panel, a third panel, and a fourth panel~~") and to recite "each said first,

second, third, and fourth panel ~~configured for~~ in parallel abutting contact" (added portions underlined, deleted portions in strikethrough).

Claim 25 is amended to delete a redundant recitation to "second panel" ("further comprising ~~a second panel~~, a third panel and a fourth panel") and to recite "each ~~second~~ said third and fourth panel including first and second planar plies ..." (added portions underlined, deleted portions in strikethrough).

Claim 26 is amended to delete redundant recitations to "second panel" ("further comprising ~~a second panel~~, a third panel and a fourth panel, each said ~~second~~, third and fourth panel including ..." (added portions underlined, deleted portions in strikethrough).

Claim 33 is amended to depend from claim 32.

Claim 49 is amended to recite "each of said first and second ventilator sections comprising ~~at least one layer~~ interconnected first and second panels, each of said first and second panels comprising a corrugated material defining a multiplicity of air passages and a plurality of apertures, the ~~at least one layer~~ defining a multiplicity of air passages and a plurality of apertures," and "each of said apertures further extending substantially through said ~~at least one layer~~ first and second layers so as to interrupt at least a portion of said multiplicity of air passages" (added portions underlined, deleted portions in strikethrough).

Claim 51 is amended to depend from claim 49.

Claim 56 is amended to depend from claim 54.

Claim 58 is amended to depend from claim 56 and to recite "each ~~said plurality of interconnected ventilator sections~~ first and second panels are interconnected by slip-scoring" (added portions underlined, deleted portions in strikethrough).

Claim 59 is amended to recite "said ~~plurality of interconnected ventilator sections~~ first and second panels" (added portions underlined, deleted portions in strikethrough).

Claim 60 is amended to recite "operably" in lieu of "operationally."

No new matter has been added by the amendments to the pending claims. In view of the foregoing amendments to the pending claims, Applicant requests reconsideration and withdrawal of all rejections.

Election/Restriction

Claims 35-48 were withdrawn from consideration along with added claims 61-70, claims 61-70 being designated as Group III in the restriction requirement of Paper No. 3. Applicant respectfully maintains traversal of the restriction requirement. Applicant specifically traverses the assertion in the Office Action that "the restriction requirement, by itself, establishes that a serious burden would be placed upon the Examiner if more than one invention were to be examined." Applicant notes that the presence of independent or distinct inventions is only one of two distinct and separate requirements to be satisfied for restriction. The other requirement is that there must be a serious burden on the examiner if restriction is required.<sup>1</sup> To this end, Applicant maintains the traversal of the restriction requirement because an undue burden has not been established by the rationale in the Office Action if all claims were rejoined. Alternatively, Applicant reserves the option of rejoining the withdrawn method claims when the claims under consideration are in condition for allowance.<sup>2</sup>

35 U.S.C. § 251

Claims 16-34 and 49-60 are rejected under 35 USC § 251, the rejection asserting an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present three issue is based. Applicant initially notes that the Office Action erroneously specified U.S. Patent 5,806,269 as the patent to be corrected and which issued from U.S. Patent Application 08/735,598; whereas U.S. Patent 5,094,041 is actually the patent for which reissue is sought, U.S. Patent 5,094,041 issuing from U.S. Patent Application 07/479,376.

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<sup>1</sup> See MPEP 803 ("There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).").

<sup>2</sup> See MPEP §821.04 ("Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.") (Emphasis added).

The rejection specifically asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "a plurality of vent panels disposed in a stack 'generally proximate to one another, [with] said plurality of vent panels defining said multiplicity of air passages' as had been inserted by amendment within claim 1 during prosecution of application serial no. [07/479,376] in order to place the application in condition for allowance." Applicant respectfully traverses this portion of the assertion. Claim 16 as amended recites "a top panel; and at least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel" and "each said at least one ventilator section in parallel abutting contact with the top panel. ... the top panel and each said ventilator first panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that the first and second planar plies and intermediate ply define a multiplicity of air passages." Applicant respectfully submits that the foregoing limitations in claim 16 are encompassed by the amendments to claim 1 of U.S. Patent 5,094,041. Claim 49 has been amended to recite "each said first panel and second panel in a contacting stacked relationship" and "each of said first and second panels comprising a corrugated material defining a multiplicity of air passages," which is also encompassed by the foregoing amendment to claim 1 of U.S. Patent 5,094,041. While the foregoing limitations to pending claims 16 and 49 are not ipsissimis verbis to the limitations in the issued claims, the limitations per se are not broader in scope.. Hence Applicant respectfully submits that the foregoing limitations are equivalent to a "stack 'generally proximate to one another'" and to the limitations amended into claim 1 of U.S. Patent 5,094,041, viz, "said plurality of vent panels defining said multiplicity of air passages."

The rejection also asserted claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "a first aperture extending through a first one of the plurality of vent panels 'and interrupting at least a portion of the multiplicity of air passages therein,'" the rejection stating the foregoing passage was inserted by amendment within claim 1 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this portion of the rejection. Claim 16 recites "the top panel defining a recessed area in with the top panel first planar ply and at least a portion of the top panel intermediate ply have been removed." Hence, claim 16 addresses the "recessed area" of the present invention and does not address the "first aperture" as a part of the present invention.

Applicant also notes that allowed claim 9 of U.S. Patent 5,094,041 addresses a corresponding limitation and also fails to recite the limitation addressed by this portion of the rejection or an equivalent thereof. Therefore, Applicant submits that improper recapture is not properly applied to this limitation with respect to claim 16 because a different embodiment is being claimed and because the embodiment claimed in issued claim 9 of U.S. Patent 5,094,041 did not recite this limitation (see also note 3 below). Claim 49, as amended, recites "each of said apertures extending generally transversely with respect to the multiplicity of air passages ... so as to interrupt a portion of said multiplicity of air passages." Therefore, an equivalent or narrower limitation is present in claim 49 as amended. In view of the foregoing rationale and limitations, Applicant respectfully traverses that the pending independent claims cancel the foregoing limitations made in order to gain allowance of U.S. Patent 5,094,041.

The Office Action further asserted claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "a second aperture extending through a second one of the plurality of vent panels 'and interrupting at least a portion of the multiplicity of air passages therein,'" the rejection asserting that the foregoing limitation had been inserted by amendment within claim 1 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this portion of the rejection. Applicant points out for reasons stated above that claim 16 recites limitations characteristic of a different embodiment of the present invention. Therefore, Applicant cannot properly be required to amend claim 16 with the foregoing limitation (see reasons provided above with respect to issued claim 9 of U.S. Patent 5,094,041). With respect to claim 49, Applicant notes the recitation of "a plurality of apertures," which includes a first and a second aperture. Applicant further notes the limitation within claim 49 (as amended) "each of said apertures further extending substantially through said first and second layers so as to interrupt a portion of said multiplicity of air passages," which is equivalent to the limitation recited in this portion of the rejection. In view of the foregoing reasons and amendments to the pending claims, Applicant respectfully requests withdrawal of this portion of the rejection.

The Office Action still further asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "at least a first vent panel and a second vent panel connected to said first vent panel such that said first vent panel is disposed above said second vent panel 'to

form a stack, said first vent panel and said second vent panel defining said multiplicity of air passages,'" the Office Action asserting that the foregoing limitation had been inserted by amendment within claim 4 during prosecution of application serial number [07/479,376] in order to place the application in conditions for allowance. Applicant respectfully traverses this portion of the rejection. Applicant respectfully points out that claim 16 (as amended) recites "a top panel; and at least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel." and "each said at least one ventilator section in parallel abutting contact with the top panel." Applicant respectfully submits that parallel abutting contact in the foregoing context is equivalent to "form[ing] a stack." Applicant further points out that claim 16, as amended, recites "the top panel and each said ventilator first and second panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that the first and second planar plies and intermediate ply define a multiplicity of air passages." Hence, Applicant respectfully submits that the foregoing claim 16 limitations are equivalent to the limitations recited hereinabove with respect to claim 4 of U.S. Patent 5,094,041. Pending claim 49, as amended, recites "each of said first and second ventilator sections comprising interconnected first and second panels ... in a contacting stacked relationship" and "each said first and second panel comprising a corrugated material defining a multiplicity of air passages and a plurality of apertures." Applicant submits that the foregoing limitations to amended claim 49 are equivalent to the limitations cited with respect to claim 4 of U.S. Patent 5,094,041.

The Office Action still yet further asserted that claims 16-34 and 49-60 (particularly claims 16 and 49] cancel limitations to "at least one first aperture extending through the first vent panel 'and interrupting at least a portion of the multiplicity of air passages,'" as had been inserted by amendment within claim 4 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this part of the rejection. Applicant respectfully points out that claim 16 recites an alternate limitation to the present invention, "a recessed area" defined by the top panel. Applicant respectfully refers the Examiner to claim 9 of U.S. Patent 5,094,041, wherein "a recessed area" is recited. Applicant notes that Applicant was not required to amend claim 9 to recite this limitation. Hence, Applicant submits that recapture is not properly asserted in the Office Action

in this context. Thus, because pending claim 16 describes an alternate embodiment to "at least one first aperture," Applicant cannot properly be required to amend this limitation into pending claim 16. Applicant further notes that pending claim 49 (as amended) recites "a plurality of apertures" and "each of said apertures further extending substantially through said first and second layers so as to interrupt at least a portion of said multiplicity of air passages." Applicant respectfully submits that the foregoing limitations in pending claim 49 are equivalent to the limitations recited in claim 4 of U.S. Patent 5,094,041.

The Office Action yet still further asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "at least one second aperture extending through the first vent panel 'and interrupting at least a portion of the multiplicity of air passages,'" as had been inserted by amendment within claim 4 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this portion of the rejection. Applicant first points out that pending claim 16 recites "a recessed area," which is an alternate embodiment of the present invention and which is recited in allowed claim 9 of U.S. Patent 5,094,041. This limitation, recited in allowed claim 9 of U.S. Patent 5,094,041, was not amended into claim 9 as a condition for allowance thereof. Pending claim 49 (as amended) recites "a plurality of apertures ... extending substantially through said first and second layers so as to interrupt at least a portion of said multiplicity of air passages." Therefore, Applicant respectfully submits that pending claim 49, as amended, recites equivalent limitations to the limitations cited above with respect to claim 4 of U.S. Patent 5,094,041.

The Office Action still further asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "each of said pair of vent parts including a plurality of vent panels 'which are interconnected and generally parallel to one another' and disposed in a stack 'generally proximate to one another, said plurality of interconnected vent panels defining said multiplicity of air passages,'" as had been inserted by amendment within claim 7 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this portion of the rejection. Pending claim 16 (as amended) recites "at least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel," "each of said at least one ventilator section in parallel abutting contact with the top panel," and "the top panel and each said ventilator first and

second panel comprising first and second planar plies and an intermediate ply disposed between the first and second planar plies such that the first and second planar plies and the intermediate ply define a multiplicity of air passages." Applicant submits that the foregoing limitations to pending claim 16 (as amended) are equivalent to the limitations cited with respect to claim 7 of U.S. Patent 5,094,041. Pending claim 49 recites "each of said first and second ventilator sections comprising a first panel and a second interconnected panel... in a contacting stacked relationship and defining a multiplicity of air passages." Applicant respectfully submits that the foregoing limitations to pending claim 49 (as amended) are equivalent to the foregoing limitations cited with respect to allowed claim 7 of U.S. Patent 5,094,041.

The Office Action asserted that the above deleted limitations were argued as a basis for patentability for claims 1, 4, and 7 on pages 8, (lines 1-6), 9, (lines 16-20), 11, (lines 1-4), and 12, (lines 1-6), of the October 10, 1990 amendment, during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant has addressed each of the foregoing asserted limitations separately hereinabove and maintains the traversals for the reasons stated above.

The Office Action asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "a pocket defined by and extending at least partially through at least a one of the vent parts with 'said pocket being spaced apart from the interior region by the vent part,'" as had been inserted by amendment within claim 8 during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Applicant respectfully traverses this portion of the rejection. Applicant asserts that the foregoing limitations cannot properly be required to be present in the pending claims. *Inter alia*, Applicant notes the rule that "the recapture rule may be avoided in some circumstances ... when the reissue claims are materially narrower in other overlooked aspects of the invention."<sup>3</sup> Applicant's

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<sup>3</sup> Hester Industries, Inc. v. Stein Inc., 46 USPQ2d 1641, 1649-1650 (Fed. Cir. 1998) ("Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 27 USPQ2d at 1525 ('Reissue claims that are broader in certain respects and narrower and others may avoid the effect of the recapture rule.); Clement, 45 USPQ2d at 1165. For example, in Ball the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as 'fundamental narrowness') despite the broadened aspects of the claims. 221 USPQ at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this

rationale is that claim 8 of U.S. Patent 5,094,041 contains extremely broad limitations except for the limitations referenced in this portion of the rejection. In the case of pending claims 16 and 49, both are materially narrower in other aspects of the invention. For example, pending claim 16 recites "at least one ventilator section comprising a ventilator first panel and an interconnected ventilator second panel in parallel abutting contact with the top panel." By further example, pending claim 49 recites "a corrugated material defining a multiplicity of air passages and a plurality of apertures" and "first and second ventilator sections generally symmetrically extending outboard from a substantially longitudinal center line." None of the foregoing limitations is recited in allowed claim 8 of U.S. Patent 5,094,041. Therefore, Applicant respectfully asserts that the recapture rule is properly avoided because pending claims 16 and 49 are narrower in other overlooked aspects of the instant invention.

The Office Action further asserted that claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to 'said pocket being at least partially enclosed along a first side disposed closest to the interior region of the roof ventilator by one of the vent parts' as well as 'said pocket being at least partially enclosed along a second side disposed closest to the exterior region surrounding the roof ventilator by said one of the vent parts' as had been argued as a basis for patentability of claim 8 on pages 2-3 of the July 1, 1991 amendment, during prosecution of application serial number [07/479,376] in order to place the application in condition for allowance. Therefore and as also shown above, the recapture rule should be avoided because pending claims 16 and 49 are materially narrower in other aspects thereof than claim 8 of U.S. Patent 5,094,041.

The Office Action further asserted claims 16-34 and 49-60 (particularly claims 16 and 49) cancel limitations to "a top panel disposed above a pair of vent parts and formed of a pair of planar plies and an intermediate ply, a recessed area cut in the top panel with the recessed area defining a plurality of openings with 'each of said plurality of openings having a pair of sidewalls defined by the intermediate ply, each of said pair of sidewalls traversing a generally oval shaped path, such that the top panel may be manually folded across a pad disposed within said recessed area,'" as had been inserted by amendment within claim 9, as well as argued on pages 4-5 of the

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exception to the recapture rule is to allow the patentee to obtain through reissue the scope of protection to which he is rightfully entitled for such overlooked aspects.").

March 4, 1991 amendment, during prosecution of application serial number [07/479, 376] in order to place the application in condition for allowance. As shown above, pending claims 16 and 49 are materially narrower in other aspects thereof than claim 8 of U.S. Patent 5,094,041. Hence, the recapture rule is properly avoided in this situation.

In view of the foregoing, Applicant submits that pending claims 16 and 49 should not be rejected under 35 U.S.C. § 251 and the recapture rule. The other rejected claims are not specifically addressed and depend directly or indirectly from claim 16 or claim 49. Hence, Applicant submits that none of the rejected claims, as amended, are now properly rejected. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 251 and the recapture rule be withdrawn.

35 U.S.C. § 112

The Office Action rejected claims 16-34, 51, and 52 under 35 USC § 112, second paragraph, as indefinite, asserting claim 16, lines 4 and 10 "each said at least one ventilator section" lacks an antecedent basis within the claim. And the limitation in claim 16, line 6, "each said ventilator first panel" lacks an antecedent basis within the claim. The rejection further asserted that it is not clear as to what is being defined by the language of claims 16-34 with lines 4-5 of claims 16 reciting "each said ventilator section configured for parallel abutting contact with the top panel." The rejection asked whether claims 16-34 define an assembled ventilator or merely portions of a ventilator which may be assembled together. Applicant respectfully traverses this portion of the rejection. Applicant points out that "each said at least one ventilator section" in line 4 of pending claim 16 has antecedent basis in line 3 thereof ("at least one ventilator section"). Applicant also points out that "each said ventilator first [and second] panel," recited in line 6 of pending and amended claim 16, has antecedent basis previously therein ("a ventilator first panel [and an interconnected ventilator second panel]"). Therefore, Applicant submits that the foregoing limitations in claim 16 have proper antecedent basis and claim 16 is not indefinite. To this end, Applicant respectfully requests withdrawal of this rejection.

With respect to claim 51, lines 1, the rejection stated that "said pluralities of first layer apertures" lacks a proper antecedent within the claim. Applicant respectfully traverses this rejection. "[s]aid pluralities of first layer apertures" has antecedent basis in claim 49, as

amended, because claim 49 recites "[a] ventilator ... comprising first and second ventilator sections ..., each of said first and second ventilator sections comprising interconnected first and second panels, each of said first and second panels comprising ... a plurality of apertures." Therefore, claim 49 recites first layer apertures for each of the first and second ventilator sections." Because claim 49 recites first layer apertures for each of the first and second ventilator sections, claim 49 is submitted not to be indefinite and withdrawal of this rejection is respectfully requested.

The Office Action stated that claims 17 appears dependent upon subsequent claim 21 and that claim 33 appears dependent upon subsequent claim 37. Claim 17 is amended to depend from claim 16 and claim 33 is amended to depend from claim 32. In view of the foregoing claim amendments, withdrawal of the rejection is respectfully requested.

Applicant submits that none of the pending claims are indefinite. However, Applicant would be receptive to suggestions from the Examiner to more distinctly claim the subject matter regarded as the invention.

35 U.S.C. §§ 102 and 103

The Office Action rejected claims 49-54 and 60 under 35 USC § 102(a) as anticipated by U.S. Patent 4,817,506 ("506 Patent") to Cashman. Applicant respectfully traverses this rejection. However, in order to advance the prosecution of the instant Application, claim 49 is amended to recite "each of said first and second panels comprising a corrugated material defining a multiplicity of air passages and a plurality of apertures." The foregoing limitation is neither disclosed nor suggested by the 506 Patent. Therefore, Applicant submits that claim 49 as amended is not anticipated by the 506 Patent. The other rejected claims depend directly or indirectly from claim 49 and, hence, are submitted to not be anticipated by the 506 Patent as well. In view of the foregoing amendment to claim 49, withdrawal of the rejection is respectfully requested.

Status of Withdrawn Claims

The Office Action required cancellation of nonelected claims or other appropriate action under 37 C.F.R. § 1.144 as explained in MPEP § 821.01. Applicant has reserved the right to

amend the withdrawn claims to contain the limitations in allowed claims. Therefore, Applicant submits that "other appropriate action" is reserved.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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